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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,221	07/24/2001	William R. Haas	10004843-1	6479

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

LEE, CHEUKFAN

ART UNIT PAPER NUMBER

2622

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/912,221	<b>Applicant(s)</b> HAAS ET AL.	
	<b>Examiner</b> Cheukfan Lee	<b>Art Unit</b> 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-16 is/are allowed.
- 6) ☒ Claim(s) 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3-11-03, 10-3-03</u> . | 6) <input type="checkbox"/> Other: _____  |

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1. Claims 1-17 are pending. Claims 1, 11 and 17 are independent.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 17 is rejected under 35 U.S.C. 102(e) as being anticipated by Gervais (U.S. Patent No. 6,373,556).

Regarding claim 17, Gervais discloses a scanner (Figs. 1 and 2) which employs a conventional flatbed scanner (11) and a light box (12), the conventional flatbed scanner having a scanner platen (scanning window 16) and inherently a light source since Gervais states that any flatbed scanner can be employed (col. 2, lines 11-27 and 36-38, col. 3, lines 1-38). The light box (12) having a stationary light source(s) (29) reads on the claimed transparency adapter having a stationary light source that is separated from the scanner light source.

After placing transparent media (X-ray transparency) on the transparency adapter (12), the transparency adapter (at least the transparent surface thereof) is inherently utilized by the user to orient the transparent media (X-ray transparency) to an input orientation. The transparency adapter (12) is closed relative to the flatbed

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scanner (11), directly transferring the input orientation to the scanner platen (scanning window 16 of scanner 11) since the input orientation is not altered. Scanning of the transparency media is then performed to obtain a scanned image with an output orientation while the stationary light source (29 in 12) illuminates the transparency media (X-ray transparency). The output orientation of the image is the same as the input orientation.

4. Claims 1-16 are allowed.

5. The following is an examiner's statement of reasons for allowance:

Independent claims 1 and 11 and their dependent claims 2-10 and 12-16 are allowable over the prior art of record, including the closest prior art Neushul (U.S. Patent No. 6,208,437) to be discussed below. Claims 1 and 11 each require that the transparency adapter comprises a light table comprising a stationary light source that operates in a light table state, in which the stationary light source illuminates transparent media for viewing, and a transparency adapter operating state, in which the stationary light source illuminates the transparent media while the media is being scanned by a scanner to create a scanned image. Further, the claims each require that the transparency adapter have a mounting device to hold the transparent media during the light table operating state. Furthermore, the claimed scanner has a scanner light source (other than the stationary light source), a scanner platen and a scanner lid.

The claimed transparency adapter operating in two states in combination with the above features are not taught by the prior art of record.

Note: The closest prior art Neushul (U.S. Patent No. 6,208,437) discloses a viewing light box scanner for scanning and viewing transmissive media images. The scanning elements include a mirror (4), lens (5) and an image sensor (6). The scanner has two states, one of which is a viewing state, in which the transmissive medium placed on transport (2) is illuminated with light source (11, only for viewing the medium) for viewing, and the other state of which is a scanning state, in which the transmissive medium is illuminated with a different and external light source (3, only for scanning) to be scanned to generate a scanned image. Neushul does not disclose a transparency adapter as claimed because the scanner of Neushul uses two different light sources for the two respective states, one light source located on one side of the viewing and scanning platen (1) and the other light source on the opposite side of the platen (1) whereas in the claimed invention, the same stationary light source comprises the two states.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Neushul (U.S. Patent No. 6,208,437) discloses a viewing light box scanner, discussed in the section for reasons for allowance.

William (U.S. Patent No. 6, 185,011) discloses a flatbed scanner with top and bottom light sources and a movable light shield.

Sheng (U.S. Patent No. 6,819,457) discloses a transparency adapter structure of a scanner having a replaceable transparency adapter.

Huang et al. (U.S. Patent No. 6,494,586) discloses a back-light module with improved light projecting assembly for an image scanner.

Huang (U.S. Patent No. 6,567,191) discloses a dual-mode optical scanner.

Chang (U.S. Patent No. 6,519,023, application filed March 6, 2002) discloses a transparency scanning mechanism of a scanner.

Lin (U.S. Patent No. 5,993,023) discloses a light generating device for a scanner.

Inoue et al. (U.S. Patent No. 5,781,311) discloses a planar light source and an image reading device.

Brook, III (U.S. Patent No. 5,574,542) discloses a scanner cover for a flatbed scanner.

Snyder et al. (U.S. Patent No. 6,177,982) discloses a template for use with a film scanner.


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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee whose telephone number is (703) 305-4867. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cheukfan Lee  
Dec. 3, 2004

A handwritten signature in black ink, appearing to read 'Cheukfan Lee', is written over a printed version of the same name.